



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

KD

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/017,735 02/03/98 GREY

H 018623-00589

EXAMINER

HM12/0327

ELLEN LAUVER WEBER, ESQ.
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER
8TH FLOOR
SAN FRANCISCO CA 94111-3834

SCHWADRON, R

ART UNIT

PAPER NUMBER

1644

DATE MAILED:

03/27/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademark

Office Action Summary

Application No.
09/017,735

Applicant(s)
Grey et al.

Examiner
Ron Schwadron, Ph.D.

Group Art Unit
1644



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 9-62 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 9-62 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. The amendment filed 9/8/99 has necessitated the following new restriction requirement. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 24,25,32,33,51,52,55,56 are drawn to methods of gene therapy classified in Class 514, subclass 44.

II. Claims 9-23,26-31,34-50,53,54,57-62 a method of inducing a CTL response, classified in Class 424, subclass 193.1. Said claims are under consideration only in so far as they encompass methods that use peptides.

2. Inventions I and II are different methods that use different ingredients. Invention I is drawn to a method of gene therapy, while invention II is drawn to a method of treatment with peptides. These methods use different ingredients and process steps. Therefore they are novel and unobvious in view of each other and are patentably distinct.

3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II and Groups I and II have acquired a separate status in the art as shown by their different classification and divergent subject matter, restriction for examination purposes as indicated is proper.

4. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

5. Applicant is required to elect the following species (as they pertain to the elected invention).

6. This application contains claims directed to the following patentably distinct species of the claimed invention. A method that recites use of:

- a) a peptide that comprises an epitope consisting of 8 residues
- b) a peptide that comprises an epitope consisting of 9 residues
- c) a peptide that comprises an epitope consisting of 10 residues

d) a peptide that comprises an epitope consisting of 11 residues

These peptides are different in that they are of different lengths.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

7. Upon selecting a peptide from a-d from the requirement enunciated in the previous paragraph of this Office Action, a further election of species is required.

The claims are generic to a plurality of disclosed patentably distinct species comprising a method that uses any particular set of peptides which is encompassed by a particular formula recited in the claims. Such species would be a peptide with a first conserved residue at the second position from the N-terminus where the amino acid was A and a second conserved residue at the C-terminal wherein the amino acid was M (eg. the peptide of claim 56 wherein one amino acid from each Markush group recited in the claim is elected). Applicant needs to select one species for examination (eg. A at first specified position, M at second specified position). These peptides are structurally and functionally distinct and encode peptides that are structurally and functionally distinct, and derived from different proteins with different functions.

Applicant is required to elect a species of peptide from one of the peptides recited in Tables 3-5. Said species should be encompassed by the elected motif formula above (eg. if applicant elects a nine amino acid peptide with A at position one and M at position two, then the peptide elected from Table 3 should have the aforementioned characteristics). Furthermore, said peptide also needs to be consistent with all other elected species chosen by applicant (eg. if applicant elects cancer antigen, then the elected peptide needs to be a cancer antigen derived peptide).

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species, even though this requirement is traversed.

8. Upon selecting a peptide from the requirement enunciated in paragraphs 6 and 7 of this Office Action, a further election of species is required. This application contains claims directed to the following patentably distinct species of the claimed invention. A method that uses:

a) a peptide comprising an immunogenic epitope not linked to another molecule

- b) peptide attached to a lipid
- c) a peptide attached to a T helper epitope
- d) a peptide attached Pan DR epitope
- e) a peptide attached to a CTL epitope
- f) a peptide linked to a carrier

These peptides are structurally and functionally distinct and encode peptides that are structurally and functionally distinct, and derived from different proteins with different functions.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

9. Upon selecting a peptide species above, a further election of species is required. This application contains claims directed to the following patentably distinct species of the claimed invention. A method that uses:

- a) peptide encoding cancer associated antigen
- b) pathogen derived peptide

These peptides are structurally and functionally distinct and encode peptides that are structurally and functionally distinct, and derived from different proteins with different functions.

10. Upon selecting a peptide species above, a further election of species is required. This application contains claims directed to the following patentably distinct species of the claimed invention. A method that uses:

- a) peptide isolated from natural source
- b) chemically synthesized peptide

These peptides are structurally and functionally distinct and encode peptides that are structurally and functionally distinct, and derived from different proteins with different functions.

11. Upon selecting a peptide species above, a further election of species is required. This application contains claims directed to the following patentably distinct species of the claimed invention:

Art Unit 1644

a) in vivo method

b) in vitro method

These methods involve different steps and reagents.

12. Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

13. Papers related to this application may be submitted to Group 1600 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Papers should be faxed to Group 1600 at (703) 308-4242.

14. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Dr. Ron Schwadron whose telephone number is (703) 308-4680. The

Serial No. 09017735

Art Unit 1644

examiner can normally be reached Monday through Thursday from 7:30 to 6:00. A message may be left on the examiners voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Ms Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703) 308-0196.

Ron Schwadron, Ph.D.

Primary Examiner

Art Unit 1644



RONALD B. SCHWADRON

PRIMARY EXAMINER

GROUP 1600 (600)